

# Notice of Allowability

Application No.

09/151,409

Examiner

S. Devi, Ph.D.

Applicant(s)

DALE, JAMES B.

Art Unit

1645

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/15/03.
2. ☒ The allowed claim(s) is/are 70-103, now renumbered as claims 1-34 respectively.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |  |  |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>39</u> . |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____.              | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                       |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance                 |
|  | 9 <input checked="" type="checkbox"/> Other Attachment.                                  |

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## **ATTACHMENT TO NOTICE OF ALLOWABILITY**

### **Applicant's After-Final Amendment**

1) Acknowledgment is made of Applicant's after-final amendment filed 10/15/03 in response to the final Office Action mailed 07/15/03. With this, Applicant has amended the specification.

### **Examiner's Amendment**

2) An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicants, an amendment may be filed as provided by 37 C.F.R. 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee. The authorization for this Examiner's amendment was provided by Mr. Jeffrey Pepe in a telephone interview on 31 October 2003:

This application has been amended as indicated below:

(a) At the end of line 5 of claim 70, the recitation --Group A-- has been inserted after the recitation 'different'.

(b) In line 3 of claims 72, 74, 91 and 93, the recitation --Group A-- has been inserted after the recitation 'different'.

(c) At the beginning of claim 75, the recitation --The-- has been added before the limitation 'fusion'.

(d) In line 3 of claim 80, the recitation 'streptococci' is replaced with --streptococcal M protein--.

(e) At the end of line 2 of claim 99, the recitation 'streptococci' is replaced with --streptococcal M protein--.

(f) In line 2 of claim 81 and 100, the recitation 'marker' is replaced with --selectable marker encoded by an expression vector--.

(g) In claim 82 and 101, the recitation 'marker is a 6xHis-tag' is replaced with --expression vector is a 6xHis-tag vector--.

(h) In claim 83, the recitation '81 wherein the marker is capable of binding a nickel resin' is replaced with --82 wherein the selectable marker binds to nickel nitrilotriacetic acid (Ni-NTA) resin--.

(i) In claim 102, the recitation '100 wherein the marker is capable of binding a nickel

resin' is replaced with --101 wherein the selectable marker binds to nickel nitrilotriacetic acid (Ni-NTA) resin--.

(j) In the last paragraph on page 16 of the specification, the abbreviation 'Ni-NTA resin' is replaced with the recitation --nickel nitrilotriacetic acid (Ni-NTA) resin'. The amendment does not introduce new matter since it was well known in the art at the time of the invention that 'Ni-NTA' was the standard abbreviation used for 'nickel nitrilotriacetic acid'. For example, see page 1 of *Qiagen News*, Issue 4, 1997 (see Applicant's attachment to the amendment filed 10/15/03).

#### **Status of Claims**

3) Claims 12, 15-17, 19, 21, 23, 27, 30-32, 34, 36-38, 40, 42, 44 and 54-69 have been canceled via the amendment filed 10/15/03.

New claims 70-103 have been added via the amendment filed 10/15/03.

Claims 70, 72, 74, 75, 82, 83, 91, 93 and 99-102 have been amended via this Examiner's amendment.

Claims 70-103 are pending and are under examination.

#### **Rejection(s) Moot**

4) The rejection of claims 12, 15-17, 19, 21, 23, 27, 30-32, 34, 36-38, 40, 42, 44 and 54-69 made in paragraph 9 of the Office Action mailed 07/15/03 under 35 U.S.C. § 112, second paragraph, as being indefinite, is moot in light of Applicant's cancellation of the claims.

5) The rejection of claims 12, 27 and those that depend from these claims made in paragraphs 10-12 of the Office Action mailed 07/15/03 under 35 U.S.C. § 112, first paragraph, as containing new subject matter, is moot in light of Applicant's cancellation of the claims.

6) The rejection of claims 12, 15, 17, 19, 21, 23, 27, 30, 31, 36, 38, 40, 42, 44, 54, 58, 59 and 63-69 made in paragraph 14 of the Office Action mailed 07/15/03 under 35 U.S.C. § 102(b) as being anticipated by Dale *et al.* (WO 94/06421, already of record) ('421), is moot in light of Applicant's cancellation of the claims.

7) The rejection of claims 27, 32 and 34 made in paragraph 15 of the Office Action mailed 07/15/03 under 35 U.S.C. § 103(a) as being unpatentable over Dale *et al.* (WO 94/06421, already of record) ('421) in combination with Pillai *et al.* (US 5,334,379, already of record), is moot in light of Applicant's cancellation of the claims.

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### Remarks

- 8) Claims 70-103, now renumbered as claims 1-4 respectively, are allowed.
- 9) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center located in Crystal Mall 1. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The CM1 facsimile center's telephone number is (703) 308-4242, which is able to receive transmissions 24 hours a day and 7 days a week. The RightFax number for submission of before-final amendments is (703) 872-9306. The RightFax number for submission of after-final amendments is (703) 872-9307.
- 10) Any inquiry concerning this communication or earlier communication(s) from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A message may be left on the Examiner's voice mail service. The Examiner can normally be reached on Monday to Friday from 7.15 a.m to 4.15 p.m. except one day each bi-week which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October, 2003

  
S. DEVI, PH.D.  
PRIMARY EXAMINER